

REMARKS

Claims 7 to 26 are now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant thanks the Examiner for acknowledging the claim for foreign priority and for indicating that all of the certified copies of the priority documents have been received.

With respect to page 2 of the Office Action, the objection to the drawings is respectfully traversed. In particular, the drawings were objected to under 37 C.F.R. § 1.83(a) ("Rule 83(a)"). While Rule 83(a) may state that a drawing is to "show every feature of the invention specified in the claims", it further states that "features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention" should be — but are not required to be — "illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation." *Importantly, 37 C.F.R. § 1.83(a) is subject to 37 C.F.R. § 1.81 which only requires a drawing "where necessary for the understanding of the subject matter sought to be patented".* Here, the terms float angle and transverse vehicle velocity are disclosed in the description and claims sufficiently whereupon their detailed illustration is not necessary for an understanding of the invention. It is respectfully submitted that amended drawings are not required in view of the disclosure of the specification.

The drawings objection is therefore respectfully traversed, and withdrawal of the objection is respectfully requested.

With respect to page 3 of the Office Action, claims 7, 8, 19, and 20 were rejected under 35 U.S.C § 112, first paragraph, as to the enablement requirement.

It is respectfully submitted that a person of ordinary skill in the art would know have knowledge of the terms float angle, breakaway state and center-of-mass velocity, which *are* all adequately described and supported in the specification. Paragraphs [0019], [0021], [0025-33], and [0035-40] describe and disclose the float angle. Similarly, paragraph [0005] discloses the breakaway state as the "skidding motion." Additional disclosure for the term breakaway state is found in paragraphs [0020], [0025], and [0035-0039]. While the Office Action is unclear whether the skid state and the breakaway states are the same, these paragraphs clearly separate the two states as two separate and distinct phases. Furthermore,

the term “center-of-mass velocity” is described and supported in the specification at paragraphs [0033-0034]. This term would be known to a person of ordinary skill in the art as the velocity of the vehicle when the vehicle’s mass acts as if it was concentrated at a single point.

Accordingly, the claimed subject matter is enabled for these reasons alone.

Still further, however, and as regards the enablement rejections of the claims, it is respectfully submitted that the Office Action’s assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. *See* M.P.E.P. § 2164. The Supreme Court established the appropriate standard as to whether any experimentation for practicing the invention was undue or unreasonable. *See* M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988)). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *Id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. *See id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” *Id.*

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” *Id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Accordingly, a

specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. *See id.*

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. *See id.* Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific

reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” *See id.* at 1222-23 (italics in original).

In the present case, the Office Action has not even asserted – let alone established -- in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above, and the terms should be known to one skilled in the art.

It is therefore respectfully requested that the enablement rejections be withdrawn in view of the foregoing.

With respect to page 3 of the Office Action, claims 7 to 26 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

As explained above, the terms float angle, breakaway state, and center-of-mass velocity are definite essentially for the reasons explained above as to the enablement rejections. It is respectfully submitted that the Office Action’s suggestion of the need for defining the terms ignores the disclosure of these terms in the specification and the knowledge that one having ordinary skill in the art would have as to these terms.

The Office Action suggests that the term sensor suite, as appearing in claims 7 and 19, be clarified. It is respectfully submitted that the term “sensor suite” is described in paragraphs [0022-0025] and [0035], but it has been changed to “sensor arrangement” to facilitate matters.

While the rejections may not be agreed with, to facilitate matters, claims 8 and 20 have been rewritten to better clarify the claimed subject matter as regards to the breakaway state being characterized by a “large change in the float angle”. Furthermore, claims 7 and 19 have been rewritten to provide antecedent basis for all claim features. The “sensor unit” and “suite” was changed to “sensor arrangement” which was previously defined in the claim. Finally, claims 8 and 20 have been rewritten to remove the term “substantially”.

Claims 9 to 18 and 21 to 26 depend on claims 7, 8, 19, and 20, and are therefore also definite.

In short, claims 7 to 26 are definite and all indefinite rejections should be withdrawn.

With respect to page 5 of the Office Action, claims 7 and 19 were rejected under 35 U.S.C. § 101, as “process steps which fail to provide a tangible result.”

It is respectfully submitted that claims 7 and 19 are written so as to define the structural aspects of a machine or apparatus under 35 U.S.C. § 101, and that claims 7 and 19 provide a useful, concrete and tangible result. The subject matter of claims 7 and 19 plainly falls within 35 U.S.C. § 101. Firstly, claims 7 and 19 are to an apparatus -- which plainly is 35 U.S.C. § 101 subject matter. In addition, the claimed apparatus is plainly useful within the meaning of 35 U.S.C. § 101 as, for example, the apparatus includes “a sensor for sensing vehicle dynamics data and rollover data.”

In M.P.E.P. § 2106, it states that while “abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods . . . employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.” Claims 7 and 19 produces a useful, concrete and tangible result to constitute a practical application of an abstract idea, law of nature or natural phenomena. As stated in M.P.E.P. § 2106, “the focus is not whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved . . . is ‘useful, tangible, and concrete.’” Claims 7 and 19 refer to an apparatus for detecting a vehicle rollover that has many safety implications. Thus, the detection of a vehicle rollover from the apparatus is the final result.

For a claim to satisfy the “tangible” requirement, the claim must set forth a practical application of that judicial exception to produce a real-world result. It is respectfully submitted that an apparatus detecting vehicle rollover has at least one practical application, which is that it provides safety for the passengers by alerting them of the vehicle rollover.

It is, therefore, respectfully submitted that claims 7 and 19 are statutory subject matter under 35 U.S.C. § 101, so that claims 7 and 19 are allowable.

With respect to page 5 of the Office Action, claims 7 to 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 6,438,463 (“Tobaru” reference).

As to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

The Office Action refers to Figs. 2, 3 and 4 of the *Tobaru* reference. It is respectfully submitted that these referenced figures do not identically disclose (or even suggest) the features of claim 7, as presented. Figure 4 apparently concerns a single control unit. Nowhere within the figure (or specification) is there any support for a **processor** connected to such a unit to determine a float angle and transverse velocity, as provided for in the context of the presently claimed subject matter. This clearly distinguishes the presently claimed subject matter as to the *Tobaru* reference.

Thus claim 7, as presented, is allowable, as are its dependent claims.

As to claim 8, the Office Action refers to Fig. 2, Fig. 3, and the text at col. 7, lines 1-16 of the *Tobaru* reference. It is respectfully submitted that the referenced figures and specification text do not identically disclose (or even suggest) the features of claim 8. These references do not provide any support for the breakdown of the determination of a vehicle rollover into 3 separate and distinct phases: the stable operating state, a breakaway state, and a skid state. *Tobaru* conversely, appears to show a singular continuous state; its reference to

Application Serial No. 10/524,810
Attorney Docket No. 10191/3731
Reply to Office Action of October 3, 2008

the "hysteresis" lines H₁-H₇, would indicate a continuance system in an infinite amount of states (in accordance with the definition of a hysteresis system).

Thus claim 8 is allowable for these reasons, and because it depends from claim 7, as presented.

Consequently, claim 7 is allowable, as are its dependent claims 8 to 18.

As to claim 19, the Office Action cites Figs. 2, 3 and 4, and the text at col. 18, lines 18-31 of the *Tobaru* reference. It is respectfully submitted that the referenced figures do not identically disclose (or even suggest) the features of claim 19. Figure 4 apparently concerns a single control unit. Nowhere within the figure (or specification) is there any support for a *processor* connected to such a unit to determine a float angle and center-of-mass velocity, as provided for in the context of the presently claimed subject matter. This clearly distinguishes the presently claimed subject matter as to the *Tobaru* reference.

Thus claim 19 is allowable, as are its dependent claims 20 to 26.

Accordingly, claims 7 to 26 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending 7 to 26 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Date: 1/23/2009

By: 

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

Reg. no.
33,865

Jan C
DEOITCH

CUSTOMER NO. 26646